

It is submitted that all claims 1 through 18 and 22 should be examined at this time. According to PCT Rule 13, claims of different categories with common special technical features do *not* lack unity. Also, see Example 1 in PCT Gazette, page 52, Part 2 I. (copy enclosed).

In the present invention, the common special technical feature in *all* claims is a composition comprising (a) a swellable hydrogel-forming polymer, also termed a superabsorbent polymer (SAP), (b) a hydrophilic polymer of dendritic structure, and (c) a water-insoluble phosphate, as recited in claim 1, for example. There may be a lack of unity only if this common technical feature lacks novelty or is obvious. See PCT Gazette page 49, part 1(a), (copy enclosed).

The examiner relies upon US 2001/0011109 to argue that the present claims are not novel. As stated above, the present claims are directed to a hydrogel-forming polymer containing a polymer of dendritic structure and a water-insoluble phosphate. U.S. 2001/0011109 is not remotely directed to hydrogel forming polymers, and does not anticipate the present claims or render them obvious.

Unity of invention in the present application is evidenced further by the International Search Report. In particular, *all* claims were searched. The standards regarding unity of invention that apply to the International Searching Authority *also* apply to the U.S. Patent Office with respect to this application. Therefore, the unity of invention requirement is fulfilled, and any reliance upon independence or distinctness of the invention is not relevant under the PCT.

In addition, M.P.E.P. §1893.03(d) provides that when making a lack of unity of invention requirement, the examiner *must* "explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." A group of inventions is considered linked as to form a single general inventive concept when a technical relationship exists among the inventions that involves at least one common or corresponding special technical feature. That common special technical feature is present in *all* of claims 1-20 and 22.

The examiner has not provided *proper* reasons why each group lacks unity with each other group specifically describing the unique special technical feature in each group as required in M.P.E.P. §1893.03(d). The examiner has considered the type of claims, composition and method of preparing, without considering the special technical features recited in, and common to, each claim, as set forth above.

In addition, the method steps of Groups II and III are essentially identical wherein, in *both* independent claims 18 and 22, a hydrogel-forming polymer is admixed with a polymer of dendritic structure and a water-insoluble phosphate. In other words, the claims of Groups II and III are each directed to preparation of hydrogel-forming polymer recited in claim 1. It is clear therefore that Groups II and III have a common technical feature.

The groups do not lack unity of invention with each other. As stated above, the process recited in Group II and Group III are essentially identical. Group I recites a hydrogel-forming polymer prepared according to the process of Group II or III. Therefore, for all the reasons set forth above, Groups I-III have a unity of invention.

The Office Action fails to indicate whether Groups I, II, and III are classified in different classes or subclasses, but, even if differently classified, the inventions are not independent for the reasons set forth above *and* because the compositions set forth in claims 1-17, and the methods set forth in claims 18-20 and 22, are so closely related that a search for applicants' composition claims would necessarily encompass a search for applicants' method claims.

Therefore, even if unity of invention arguably is lacking, no evidence exists that a search and examination directed to all claims would be a *serious burden* on the examiner, as is required by M.P.E.P. §803. ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required.")

Because search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both

the applicants and the Patent Office to prosecute the product by process, method, and carrier material claims in separate applications. Search and examination of all groups of claims in a single application would be much more efficient than requiring the Patent Office to prosecute the process, hygiene article, and carrier material claims in separate applications. Search and examination of all groups of claims in a single application would be much more efficient than requiring the Patent Office and applicants to do so in separate applications. Accordingly, it is submitted that all claims should be examined at this time.

Reconsideration and withdrawal of the restriction requirement are respectfully requested. An early action of the merits on all claims is solicited.

With respect to the examiner's question regarding U.S. Serial No. 11/089,276, the assignee of the above-identified application and the assignee of 11/089,276 cooperated in discovering the subject matter of these applications. I have been informed that the applications are not two independent, unrelated applications.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

Dated:

Respectfully submitted,

By 

James J. Napoli

Registration No.: 32,361  
MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive, Suite 6300  
Sears Tower  
Chicago, Illinois 60606-6357  
(312) 474-6300  
Attorney for Applicant

S-03/2001 (E)  
30 August 2001

PCT Gazette - Section IV

49

## ANNEX B UNITY OF INVENTION

### Part 1

#### Instructions Concerning Unity of Invention

(a) **Unity of invention.** Rule 13.1 deals with the requirement of unity of invention and states the principle that an international application should relate to only one invention or, if there is more than one invention, that the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept.

(b) **Technical Relationship.** Rule 13.2 defines the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an international application. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding "special technical features." The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).

(c) **Independent and Dependent Claims.** Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed—for example, product, process, use or apparatus or means, etc.).

(i) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim avoids the prior art and the combination claim includes all the features of the subcombination.

(ii) If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) may be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

(iii) This method for determining whether unity of invention exists is intended to be applied even before the commencement of the international search. Where a search of the prior art is made, an initial determination of unity of invention, based on the assumption that the claims avoid the prior art, may be reconsidered on the basis of the results of the search of the prior art.

(d) **Illustrations of Particular Situations.** There are three particular situations for which the method for determining unity of invention contained in Rule 13.2 is explained in greater detail:

- (i) combinations of different categories of claims;
- (ii) so-called "Markush practice"; and
- (iii) intermediate and final products.

Principles for the interpretation of the method contained in Rule 13.2, in the context of each of those situations are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of Rule 13.2.

Examples to assist in understanding the interpretation on the three areas of special concern referred to in the preceding paragraph are set out below.

(j) Rule 13.3 is not intended to constitute an encouragement to the use of alternatives within a single claim, but is intended to clarify that the criterion for the determination of unity of invention (namely, the method contained in Rule 13.2) remains the same regardless of the form of claim used.

(k) Rule 13.3 does not prevent an International Searching or Preliminary Examining Authority or an Office from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or the claims fee system applicable in that Authority or Office.

## Part 2

### Examples Concerning Unity of Invention

The application of the principles of unity of invention is illustrated by the following examples for guidance in particular cases.

#### I. Claims in Different Categories

##### Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.

##### Example 2

Claim 1: A process of manufacture comprising steps A and B.

Claim 2: Apparatus specifically designed for carrying out step A.

Claim 3: Apparatus specifically designed for carrying out step B.

Unity exists between claims 1 and 2 or between claims 1 and 3. There is no unity between claims 2 and 3 since there exists no common special technical feature between the two claims.

##### Example 3

Claim 1: A process for painting an article in which the paint contains a new rust inhibiting substance X including the steps of atomizing the paint using compressed air, electrostatically charging the atomized paint using a novel electrode arrangement A and directing the paint to the article.

Claim 2: A paint containing substance X.

Claim 3: An apparatus including electrode arrangement A.

Unity exists between claims 1 and 2 where the common special technical feature is the paint containing substance X or between claims 1 and 3 where the common special technical feature is the electrode arrangement A.

However, unity is lacking between claims 2 and 3 since there exists no common special technical feature between them.